

comparing each five card row and column group of cards to predefined poker rules to determine ten hand rankings.

### **REMARKS**

The Office Action mailed October 3, 2001 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that the application is now in a form for allowance. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

The following remarks when coupled with the revision to those claims hereinabove should provide the requisite distinction for the Examiner to conclude that this application merits passage to issue. In essence, the claims have been amended to narrow or revise the claims to negate the outstanding rejections. The amendments to the claims are necessary to place the claims in a form for passage to the issue branch. The amended claims do not contain any new limitations or changes that would raise new issues.

For the foregoing reasons, it is submitted that the proposed amendments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the application is now in condition for allowance. Such action therefore is respectfully requested.

At the outset, undersigned notes that the Office Action Summary at issue herein reflects an improper case status. That is, the "Responsive to communication(s) filed on 01

September 2000" as indicated is incorrect. 01 September 2000 is the filing date for this patent application. Undersigned wishes to note that an intervening First Office Action was mailed on December 27, 2000 and a responsive Amendment was provided on May 21, 2001. Additionally, a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed on June 6, 2001 and a responsive Supplemental Amendment was provided on July 7, 2001. Furthermore, in response to a telephonic request from SPE Chapman, an additional Supplemental Amendment was filed by facsimile on August 30, 2001 (reflecting clarification as requested regarding elected claims).

Undersigned also wishes to acknowledge telephonic interviews with Examiner Legesse and SPE Sewall regarding this current office action. Those discussions, inter alia, related to this being a final office action, and in the opinion of undersigned, a premature final office action, and possible revisions to the claims pending to further the case to allowance. No agreement was reached regarding appropriate claim amendments. SPE Sewall did suggest requesting reconsideration of this being a final office action and that such request would be seriously considered.

#### **Request for Reconsideration**

Undersigned requests that the Examiner reconsider having made this office action final. It should be noted that applicant has been fully responsive to all office inquiries including, but not limited to, the first and only other office action. In particular, it should be noted that the prior art of record being relied on in the present office action was not relied on or in any way presented in the first office action. In fact, undersigned provided a 13 page response to the first office action and amended and added claims in

good faith based on the prior art made of record and relied on by the Examiner in the first office action (undersigned acknowledges that there has been a change in Examiners between the first office action and this second and final office action). None of undersigned's 13-page response was rebutted or even acknowledged in any way in the office action at hand.

It should also be noted that the majority of this second and final office action is based upon a 35 USC §102(e) reference that issued on April 24, 2001 and the remainder is based upon a 35 USC §103 reference. Undersigned also wishes to note that any suggestion that these new references were necessitated by amendments to the last office action is spurious at best. One can see by a simple review of the file that the amendments made in response to the last office action were in direct response to the issues raised by the Examiner in the last office action. While undersigned has made a good faith effort to respond to these hitherto unknown prior references herein, the finality of this office action is patently unfair; not to mention causing a notice of appeal along with the requisite fee to be filed so as to not jeopardize the status of this application. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims...." MPEP 706.07(a). For the above stated reasons, undersigned respectfully requests the Examiner reconsider and withdraw this office action from final in accordance with the spirit, if not letter, of the MPEP.

#### **Rejections Under 35 U.S.C. §102**

The Examiner had rejected claims 1-2, 4-6, 21-26, and 29-32 under 35 USC §102(e) as being anticipated by Holmes (U.S. Pat. No. 6,220,959 – the '959 patent). Inter

alia, the Examiner contends that Applicant's element of "selecting none, some, or all of the cards to be held in the NxN array of cards of any said cards within said NxN array" is met by Holmes' specification at Column 4, lines 43-46. However, column 4, lines 43-46 state: "... from deck C, row 160 is dealt from deck D and row 180 is dealt from deck E. Alternatively, all of the cards can be dealt from a single deck of cards or all the cards can be dealt from two or more multiple decks of cards that have been all ...." Undersigned fails to appreciate this reference in light of this element. Furthermore, it is clear from column 5, lines 28-31, that a player is REQUIRED to hold ONLY one card per row and that card is then duplicated somewhere with the row.

In the preferred embodiment of the present invention, the player now selects one of the cards in each horizontal row to be held. Each card that is held by the player is duplicated once into an adjacent position on the same row.

'959 Patent, column 5, lines 28-31 (emphasis added). Being limited to holding one card per row is not the same as being able to hold ANY card in an NxN array, which Applicant's invention provides. Thus, anticipation simply cannot be found. Applicant, by and through undersigned, has made an effort to amend the claims to make this point clear. In fact, this was done in the first office action response. If the Examiner believes that this is not clear enough in the claims, undersigned requests a suggestion from the Examiner as to language that would make this element more clear. The inventions of Applicant and Holmes are patently distinct. Holmes neither teaches nor suggests a poker game to be played in a manner other than via the duplication requirement. Applicant has invented a completely different poker game. Applicant's invention, allows a player to

select ANY cards within the NxN array to be held or not. This provides an interesting new and challenging experience. I would encourage the Examiner to obtain a deck of playing cards and try the game. It is a quite fun and a different experience than Holmes' game or any other game in the market. Undersigned has available an electronic version of the game should the Examiner wish a copy to play. Applicant, unlike Holmes does not require any duplication or limitation as to the number of cards-held.

Next, the Examiner contends that Holmes teaches dealing new cards to replace unheld cards. Undersigned contends that Holmes is inoperative when attempted with standard playing cards. For example, if one of the rows dealt includes four of a kind (e.g. Ace of hearts, Ace of clubs, Ace of Diamonds, and Ace of spades), in Holmes the player is required to hold one card and replace the rest. If the player holds one of the cards from the four of a kind, how does that card get duplicated (all the Aces are already gone)? It is known in the art that standard cards include four suits, resulting in four of each card (one per suit). Where is the duplicated card coming from and where are the replacement cards for the unheld cards coming from? Holmes does not say. Holmes suggests dealing from a single deck, but if one looks closely, Holmes does not describe where the duplicated cards and the replacement cards come from. Thus, to put it clearly, Holmes cannot anticipate that which it does not teach. Furthermore, however, Holmes is inoperative with normal playing cards. Be that as it may, the claims pending in this case have been amended to provide further distinction vis-à-vis Holmes and this point, to wit:

discarding all face up cards that were not selected to be held in said NxN array of cards;

dealing new cards to randomly replace [unselected] all said discarded cards within said NxN array of cards;

3 Please note that random precludes duplication as duplication requires a non-random selection. Also, Holmes does not discard ALL face up cards, but duplicates the held card onto one of the face up card spots. Again, anticipation cannot lie where an element cannot be performed. ". . . [A]nticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference." Akzo N.V. v. United States ITC, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986). ". . . [A]nd must be arranged as in the claim[s] . . ." Carella v. Starlight Archery & Pro Line Co., 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986). In addition, ". . . [the] absence from the reference of any claimed element negates anticipation." Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

### **Rejections Under 35 U.S.C. §103**

The Examiner had rejected claims 3, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Holmes in view of Dietz, II (U.S. Pat. No. 5,704,835). The Examiner contends that Dietz discloses a game where the NxN array of cards is a 3x3 (column 3, lines 51-53) and that Dietz also discloses three card diagonal groups (refer Fig. 2).

While undersigned appreciates that the Examiner has noted that Holmes fails to teach a 3x3 array of cards, diagonal paylines for three card groups, nor purchase of three card groups in a sequential order, the Examiner has taken Holmes and Dietz out of context to try to force them together. First of all, Dietz teaches a slot machine game

having traditional slot reels and reel strips (see column 5, lines 24-35). Dietz neither teaches nor suggests a poker game. Holmes does not suggest combining with slot machines and Dietz does not suggest combining with poker games. In fact, the opposite is true. Dietz distinguishes slot machines from poker games (see column 1, lines 16-23). Dietz teaches away from combining with poker games. Thus, a 103 rejection cannot be present.

Next the Examiner rejected claim 7 under 35 USC §103(a) as being unpatentable over Holmes. The Examiner contended that 12 said N card arrangements disclosed by Holmes opens the door for players to extend the complexity of the game to whatever levels they choose to play. However, the Examiner failed to cite to any suggestion in Holmes to purchase the 12 N card arrangements in a predetermined order. As stated in MPEP 2143.03, "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 Fed.2d 981, 18 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 Fed.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Undersigned is not surprised that the Examiner can or has found isolated references which have coincidental similarity with aspects of the present invention. That, however, is not the test for patentability. These references, however, require an enabling teaching apart from applicant's own disclosure.

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. §103 which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." Lindemann Mashcinenfabrick GmbH v. American Hoist and Derrick Co., 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." Uniroyal, Inc. v. Rudkin-Wiley Corp., 437 F.2d 1044 (Fed. Cir. 1988).

These precedents, which are decisions from the Court of Appeals for the Federal Circuit are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

When a cited reference not only fails to teach the element in question, and instead teaches away from it, that reference cannot be deemed applicable. Furthermore, applicant's invention solves a different problem than the references, and such different problem is recited in the claims. In re Wright, 6 U.S.P.Q.2d 1959 (1988).

In addition, there is no teaching or motivation in any of the prior art of record which appreciates the existence of the problem solved by the present invention. Thus,



applicants recognition of the problem is, in itself, strong evidence of the nonobviousness of the invention. In re Nomiya, et al., 184 U.S.P.Q. 607, 612 through 613 (CCPA 1975).

Moreover, the fact that those skilled in the art have not implemented the invention, despite its great advantages and a strong incentive to do so indicates that it is not obvious.

It is undersigned sincere belief that all issues raised by the Examiner in the last Office Action have been satisfactorily addressed herein. However, undersigned also believes that an interview with the Examiner may resolve any outstanding issues and further the prosecution of this case. Accordingly, the Examiner is respectfully requested to call undersigned and suggest a convenient time when such an interview may be conducted.

The Examiner is respectfully requested to note that the Office Action to which this amendment responds was mailed on 10/03/01, thereby requiring a response on 03/03/02. 03/03/02 was a Sunday. Therefore this amendment is timely filed on Monday, 03/04/02.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: 3/4/02

Respectfully Submitted:

A handwritten signature in cursive script, appearing to read "Vic Gallo", written over a horizontal line.

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**Version with markings to show changes made**

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Claim 1 (twice amended) - A method for playing a poker game, comprising in combination:

dealing, face up, a NxN array of cards;

selecting none, some, or all of the cards to be held in [the] said NxN array of cards of any said cards within said NxN array;

discarding all face up cards that were not selected to be held in said NxN array of cards;

dealing new cards randomly to replace [unselected] all said discarded cards within said NxN array of cards; and

determining the poker hand rankings of predefined N card arrangements.

Claim 21(amended) - A method for playing a poker game, comprising in combination:

dealing, face up, a NxN array of cards;

selecting some, none, or all of any of the cards within said NxN array of cards to be held;

discarding all unselected cards and replacing [unselected] said discarded cards with randomly selected new cards; and

determining the poker hand rankings of predefined N card arrangements wherein any said card is implicated in at least two N card arrangements of hands.

Claim 29 (amended) - A method for playing a poker game utilizing a standard 52 card playing deck, comprising in combination:

dealing 25 cards face up in a five row by five column arrangement;

permitting a player to hold none, some, or all of any of said 25 cards;

discarding all cards that were not held by the player;

replacing each card not held with a randomly selected card from the remaining cards in the deck; and

comparing each five card row and column group of cards to predefined poker rules to determine ten hand rankings.